

## **REMARKS**

### **Foreign Priority**

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

### **Status Of Application**

Claims 1-17 are pending in the application; the status of the claims is as follows:

Claims 1-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,768,483 to Maniwa et al. (the "Maniwa patent").

Claims 11-17 are rejected under 35 USC § 103 (a) as being unpatentable over the Maniwa patent in view of U.S. Patent No. 5,800,081 to Teradaira et al. (the "Teradaira patent").

### **Drawings**

A Request for Approval of Proposed Drawing Changes Under 37 C.F.R. § 1.121 is submitted herewith for consideration by the Examiner. The proposed changes include changing the wording in boxes 1-2 and 1-5 in Fig. 5. The indication in the Notice of Draftsperson's Patent Drawing Review that the Official Draftsperson has objections to the drawings under 37 C.F.R. § 1.84, is noted. Applicants propose to submit corrected formal drawings upon receipt of a notice of allowance.

### **Claim Amendments**

Claims 1-14, and 16 have been amended to improve the format of the claims. The amendments, which were made in a manner that does not affect the scope or the substance of the claims, were not necessitated by prior art.

### **35 U.S.C. § 102(e) Rejection**

The rejection of claims 1-10 under 35 U.S.C. § 102 (e), as being anticipated by the Maniwa patent, is respectfully traversed based on the following.

Claim 1 of the present application is directed to a device for selecting a network-connected image forming apparatus from a plurality of image forming apparatus. Claim 1 requires in relevant part:

a controller for selecting one of the plurality of image forming apparatuses connected with the network, wherein **when the job has a specific mode, said controller selects an image forming apparatus storing a specific mode job**, said controller registers the job in the selected image forming apparatus.

(Emphasis added.)

That is to say, when the job has a specific mode requirement, the controller selects an image forming apparatus storing a specific mode job.

In contrast, the network printing/scanning system of the Maniwa patent queues its print jobs **time-sequentially**. (See Abstract, and col. 3, lines 6-39). Each job is sent to the printer controller in sequence and an appropriate print message is generated and sent to the specified job owner to indicate the state of the print job, i.e., whether or not it has printed. The system of the Maniwa patent does not determine the printer based on a specific mode of a job or a specific mode job stored in a printer. That is to say, the Maniwa patent does not disclose a device comprising a controller, which “**selects an image forming apparatus storing a specific mode job**”. Therefore, as the Maniwa patent does not disclose each and every limitation of claim 1, claim 1 is not anticipated by the Maniwa patent. As claims 2-10 depend either directly or indirectly from non-anticipated independent claim 1, and as dependent claims are held to incorporate all the limitations of the base claim and any intervening claims from which they depend, claims 2-10 are also not anticipated by the Maniwa patent.

Accordingly, it is respectfully requested that the rejection of claims 1-10 under 35 U.S.C. § 102 (e) as being anticipated by the Maniwa patent, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejection**

The rejection of claims 11-17 under 35 U.S.C. § 103 (a), as being unpatentable over the Maniwa patent in view of the Teradaira patent, is respectfully traversed based on the following.

Claim 11 is directed to an image forming apparatus requiring in relevant part:

a memory for storing jobs;  
**discriminating means for discriminating whether any of the jobs stored in the memory is a specific mode job in order to determine a status of the memory; and**  
**reporting means for reporting the status of the memory.**

(Emphasis added.)

That is to say, claim 11 requires that the discriminating means determine if any of the jobs stored in the memory of the image forming apparatus is a specific mode job to determine a status of the memory. Further, claim 11 requires a reporting means for reporting the status of the memory.

In contrast, the Maniwa patent does not disclose or suggest a **discriminating means for discriminating whether any of the jobs stored in the memory of the image forming apparatus is a specific mode job in order to determine a status of the memory**. The MFSA.NLM (Multi-function Service Agent network printing system) of the Maniwa patent merely checks to see if the user requesting the job is registered (col. 17, lines 58-60) and if so attaches a print profile to the print job (col. 17, lines 60-63). If the user has logged out, the MFSA.NLM temporarily stores the corresponding message to the user regarding the status of the print job. (col. 17, lines 19-32). As is acknowledged in the Office Action, the Maniwa patent does not teach “report means for replying a state of the memory”. Therefore, claim 11 is not obvious with respect to the Maniwa patent.

The Teradaira patent is directed to a printing apparatus having a status data generating circuit for generating status data of the printing apparatus when the status of a printer changes and directing that information to the host computer. The Teradaira patent does not disclose

or suggest a discriminating means for discriminating whether any of **the jobs stored in the memory of the image forming apparatus** is a specific mode job to determine a status of the memory. Therefore, claim 11 is not obvious with respect to the Teradaira patent.

Further, there is no suggestion or motivation to combine the two references, nor would such a combination provide the apparatus of claim 11. Therefore, claim 11 is not obvious with respect to the Maniwa patent in view of the Teradaira patent. As claims 12-15 depend either directly or indirectly from non-obvious independent claim 11, they too are not obvious with respect to the Maniwa patent in view of the Teradaira patent.

Claim 16 of the present application is directed to a network system comprising in relevant part:

a network for transmitting data;  
a plurality of image forming apparatuses connected with said network  
and each of the plurality of image forming apparatuses having a memory for  
storing jobs;  
**discriminating means for discriminating whether the memory  
stores a specific mode job indicating a status of the memory;**  
**reporting means for reporting to the network the status of the  
memory;** and  
**a control device for selecting one of said plurality of image forming  
apparatuses connected with a network and registering a job in the selected  
image forming apparatus, wherein said control device selects a  
predetermined image forming apparatus when the job is a specific mode  
job.**

(Emphasis added.)

That is to say, claim 16 requires that the discriminating means determine if a job stored in the memory of the image forming apparatus is a specific mode job. Claim 16 also requires a reporting means for reporting the status of the memory. Further, claim 16 requires **a control device for selecting one of said plurality of image forming apparatuses wherein said control device selects a predetermined image forming apparatus when the job is a specific mode job.**

In contrast, as described above, the Maniwa patent does not disclose or suggest a **discriminating means for discriminating whether a job stored in the memory of the**

**image forming apparatus is a specific mode job to determine a status of the memory.**

As is acknowledged in the Office Action, the Maniwa patent does not teach “report means for replying a state of the memory”. Therefore, claim 11 is not obvious with respect to the Maniwa patent. Further, the Maniwa patent does not disclose or suggest a control device which selects **a predetermined image forming apparatus** when the job is a specific mode job. Therefore, claim 16 is not obvious with respect to the Maniwa patent.

As discussed above, the Teradaira patent is directed to a printing apparatus having a status data generating circuit for generating status data of the printing apparatus when the status of a printer changes and directing that information to the host computer. The Teradaira patent does not disclose or suggest a discriminating means for discriminating whether any of **a job stored in the memory of the image forming apparatus** is a specific mode job to determine a status of the memory. Therefore, claim 16 is not obvious with respect to the Teradaira patent. As claim 17 depends directly from non-obvious independent claim 16, claim 17 is also not obvious with respect to the Teradaira patent.

Further, there is no suggestion or motivation to combine the two references, nor would such a combination provide the system of claim 16 of the present application. Therefore, claim 16 is not obvious with respect to the Maniwa patent in view of the Teradaira patent. As claim 17 depends directly from non-obvious independent claim 16, claim 17 is also not obvious with respect to the Maniwa patent in view of the Teradaira patent.

Accordingly, it is respectfully requested that the rejection of claims 11-17 under 35 U.S.C. § 103 (a), as being unpatentable over the Maniwa patent in view of the Teradaira patent, be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley & Austin Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley & Austin Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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April 19, 2001



## APPENDIX

### VERSION WITH MARKINGS TO SHOW CHANGES MADE

The following is a marked-up version of the changes to claims which are being made in the attached response to the Office Action dated February 1, 2001.

#### IN THE CLAIMS:

1. (Amended) A device for selecting a network-connected image forming apparatus from a plurality of network-connected image forming apparatuses, at least one of the plurality of image forming apparatuses having a specific mode job, the device comprising:

a controller for selecting [an] one of the plurality of image forming [apparatus] apparatuses connected with [a] the network, wherein when the job has a specific mode, said controller selects an image forming apparatus storing a specific mode job, said controller registers the [and registering a] job in the selected image forming apparatus. [apparatus, wherein said controller selects an image forming apparatus storing a specific mode job when the job is a specific mode.]

2. (Amended) A device according to claim 1, wherein said selected image forming apparatus is adapted to form images of a specific mode job [is a job requiring temporary stop of a] which requires temporarily stopping the selected image [forming.] forming apparatus.

3. (Amended) A device according to claim 2, wherein said [specific mode job is a job possessing] selected image forming apparatus has a manual feed paper supply specific mode.

4. (Amended) A device according to claim 2, wherein said selected image forming apparatus is adapted to form an image of [specific mode job is] a job possessing a specific mode requiring changing paper positioned in the selected image forming apparatus. [exchange of a paper.]

5. (Amended) A device according to claim 2, further comprising:  
notice means for notifying a user to [set a] place an indicated type of paper in the selected image forming apparatus. [using the job to the selected image forming apparatus.]
6. (Amended) A device according to claim 1, wherein said controller selects [an] one of the plurality of image forming [apparatus] apparatuses not storing a specific mode job when the job does not have [is not] a specific mode.
7. (Amended) A device according to claim 1, wherein said controller selects an image forming apparatus not storing a job in a memory when an image forming apparatus storing a specific mode job cannot be referenced.
8. (Amended) A device according to claim 7, wherein said controller selects an image forming apparatus having [the greatest] a greater remaining memory than any other of the plurality of image forming apparatuses when an image forming apparatus not having a job stored in memory [storing no job] cannot be referenced.
9. (Amended) A device according to claim 1, wherein said controller receives information from an image forming apparatus regarding [the] a size of paper [attached to] in the image forming apparatus, and  
wherein said controller selects an image forming apparatus storing a specific mode job and registers a job in the selected image forming apparatus when no image forming apparatus has [a] paper suitable for the job.
10. (Amended) A device according to claim 9, further comprising:  
notice means for notifying a user to [set a] place an indicated type of paper in the selected image forming apparatus. [using the job to the selected image forming apparatus.]
11. (Amended) An image forming apparatus connected with a network comprising:  
a memory for storing jobs;  
[discriminate] discriminating means for discriminating whether any of the jobs stored in the memory [stores] is a specific mode job in order to determine a status of the memory;



and [or not;]

[report] reporting means for reporting the status [replying a state] of the memory.

12. (Amended) An apparatus according to claim 11, wherein said memory stores a specific mode job [is a job] requiring temporary [stop of a] stoppage of the image forming apparatus. [forming.]

13. (Amended) An apparatus according to claim 12, wherein said memory stores a specific mode job [is a job possessing] requiring a selected image forming apparatus having a manual feed paper supply mode.

14. (Amended) An apparatus according to claim 12, wherein said memory stores a specific mode job [is a job possessing a mode] requiring changing paper positioned in the selected image forming apparatus. [exchange of a paper.]

16. (Amended) A network system comprising:  
a network for transmitting [a] data;  
a [plural] plurality of image forming [apparatus] apparatuses connected with said network and each of the plurality of image forming apparatuses having a memory for storing [jobs,] jobs;

[discriminate] discriminating means for discriminating whether the memory stores a specific mode job indicating a status of the memory; [or not and]

[report] reporting means for reporting to the network the status [replying a state] of the memory; and

a control device for selecting one of said plurality of image forming apparatuses connected with a network and registering a job in the selected image forming apparatus, wherein said control device selects a predetermined image forming apparatus when the job is a specific [mode.] mode job.